

REMARKS

Claims 1-12 are pending and stand rejected. Claims 1, 2, and 4 are amended herein. Support for these amendments can be found, for example, in paragraph [0023] of the specification and FIG. 1. No new matter is added herein.

Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

Amendments to the Specification*Priority*

Applicants have amended the specification to add a paragraph identifying the present application as a national stage filing under 35 U.S.C. § 371 entitled to priority of German application DE 10138302.9.

Rejection Under 35 U.S.C. § 102(d)

The Examiner rejects claims 1-12 under 35 U.S.C. § 102(d) as barred by the disclosure of the claimed invention in German Patent Application DE 10138302.9 filed more than twelve months prior to the filing date of the current application. Applicants respectfully traverse this rejection.

The present application is a national stage filing under 35 U.S.C. § 371 of PCT International Application PCT/EP02/09010, filed August 12, 2002, which in turn claims priority to German Patent Application No. DE 10138302.9, filed August 10, 2001.¹ The present application was filed in the United States on February 10, 2004, the 30-month anniversary of the August 10, 2001 priority date. As required by 35 U.S.C. § 371, the present application was accompanied by the basic national fee² and a copy of the International Patent Application. The

¹ August 10, 2002 fell on a Saturday, such that the filing of the International Application on August 12, 2002 was timely.

² In fact, a fee in excess of the basic national fee.

Declaration was timely filed in response to a Notice to File Missing Parts of Nonprovisional Application mailed May 6, 2004.

In accordance with 37 C.F.R. § 1.55(a)(1)(ii), this claim for priority is being made during the pendency of the application and within the time limits set forth in the PCT and the Regulations under the PCT. No petition or fee is required. Having therefore established that the present application is entitled to claim priority to the asserted reference, Applicants respectfully submit that the rejection under section 102(d) is improper and should be withdrawn.

Rejection Under 35 U.S.C. § 102(e)

The Examiner rejects claims 1-4, 6-8, and 10-12 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,875,399 to McVey ("McVey"). To anticipate a claim, a single prior art reference must expressly or inherently disclose each and every element of the claimed invention. MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987)). Applicants respectfully submit that McVey fails to meet this standard.

Claim 1 recites that "the first and second infrared-permeable windows (3, 4) and the measurement section *are located in a measuring cuvette (1)*" (emphasis added). Claim 2 similarly recites that the measuring cuvette includes "a first infrared-permeable window (3), and a second infrared-permeable window (4)...." That is, the measuring section and the infrared-permeable windows are part of the cuvette. Specification, paragraph [0023].

McVey, by contrast, teaches first and second infrared-permeable windows 112, 116 that are integrated into the housings 108, 118 of the transmitting and receiving portions 98, 94, respectively. McVey, Col. 11, Lines 23-34. Thus, they are not part of hollow body 102, which the Examiner analogizes to the measuring section of the present invention. Thus, McVey fails to teach each and every element of claims 1 and 2. Applicants accordingly respectfully request withdrawal of the rejection.

Claims 3, 4, 6-8, and 10-12 depend from claim 1. It is axiomatic that claims depending from allowable claims are allowable as well. Thus, for at least the foregoing reasons, Applicants earnestly solicit the Examiner to withdraw the rejection of dependent claims 3, 4, 6-8, and 10-12.

Rejections Under 35 U.S.C. § 103

The Examiner rejects claims 5 and 9 under 35 U.S.C. § 103 as obvious over McVey. To establish a *prima facie* case of obviousness, the Examiner must demonstrate some suggestion or motivation to combine one or more references, with a reasonable expectation of success, to teach each and every claimed limitation. MPEP § 2142. Applicants respectfully traverse the rejections.

As described above, McVey fails to teach each and every element of claim 1. Claims 5 and 9 both depend from claim 1. Therefore, for at least the reasons set forth above with respect to claims 1 and 2, Applicants submit that claims 5 and 9 are not *prima facie* obvious. Applicants accordingly respectfully request withdrawal of this rejection.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, and request that all objections and rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

Applicants believe that a two month extension of time is necessary for this paper to be considered timely filed, and hereby petition for such extension under 37 C.F.R. § 1.136. Please charge the extension fee of \$450.00, and credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 87333.2462.

Respectfully submitted,

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